

## **REMARKS**

### **A. Objection to Claims**

In the Office Action mailed on June 17, 2004, claim 12 was objected to for an informality. In particular, claim 12 was objected to for using “surface” instead of “face” as recited in the preamble. In view of the present amendment that replaces “surface” with “face” the objection has been overcome and should be withdrawn.

Please note that the amendments of claim 12 is being presented to correct an obvious typographical error, to add “said” to reflect the amendment of claim 11 and does not change the intended meaning of the original claim. Accordingly, the amendments of claim 12 are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722, 122 (2002).

### **B. 35 U.S.C. §112, Second Paragraph**

Claims 1-13 were rejected under 35 U.S.C. § 112, second paragraph as being unclear in meaning. In particular, the rejection asserted that the directional attachment of the scale element to the installation face of the first body mentioned in the preamble was missing from the body of claims 1 and 11. Applicants traverse the rejection in that it was their intent for the structural elements recited in the preambles of claims 1 and 11 to be considered part of the claims since the recited structural elements breathed life into the claims.

Despite the improperness of the rejection, claims 1 and 11 have been amended to insert structural elements in the preambles of the claims into the body of the claims. Since the structural relationship in the bodies of the claims are clear in meaning and consistent with the

language of the preambles, the rejection is overcome and should be withdrawn.

It is noted that claims 1-13 have not been rejected based on the prior art. Accordingly, claims 1-13 should be allowed.

Note that claims 1 and 11 have been amended to reiterate the language of their preambles in that they now recite in the body of the claim that the first body comprises an installation face and that the scale element is part of a linear position measuring system. Since the amendments do not alter the intended meaning of the original claims, the amendments are not being presented for reasons of patentability as defined in *Festo*.

Furthermore, claims 1 and 11 have been amended to further clarify that the alignment of the scale element is with respect to the installation face. Since such alignment is inherent from the original claims, the amendments do not alter the intended meaning of the original claims and so the amendments are not being presented for reasons of patentability as defined in *Festo*.

**C. Claims 1-11 and 13**

Applicants note with appreciation that claims 1-11 and 13 have been indicated to be allowable once the rejection under 35 U.S.C. § 112, second paragraph has been overcome. As pointed out in Section B, the rejection has been overcome and so the claims should be allowed.

**D. Claim 12**

Applicants note with appreciation that claim 12 has been indicated to be allowable once the objection and rejection under 35 U.S.C. § 112, second paragraph have been overcome. As pointed out in Sections A and B, the objection and rejection have been overcome and so the claim should be allowed.

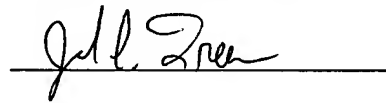
**F. New Claims 14-18**

Please note that new claims 14-18 are being presented to provide additional coverage for a device and method for the directional attachment of a scale element of a linear position measuring system to an installation face of a first body. Accordingly, the new claims are not being presented for reasons of patentability as defined in *Festo*.

**CONCLUSION**

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-18 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorney at (312) 321-4200.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "John C. Freeman", is written over a horizontal line.

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